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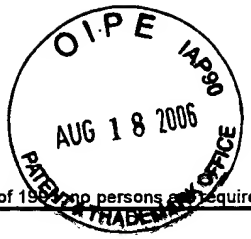

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
05793.3051-00000

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number	Filed
09/780,468	February 12, 2001
First Named Inventor	
Joseph D. Lilly et al.	
Art Unit	**Examiner**
3628	Nguyen, Nga B.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☐ attorney or agent of record.
Registration number _____.

☒ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 57,502

Patrick L. Miller
Signature

Patrick L. Miller
Typed or printed name

202-408-6062
Telephone number

August 18, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 form is submitted.

PATENT
Attorney Docket No. 05793.3051-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	
Joseph D. Lilly et al.	Group Art Unit: 3628
Application No.: 09/780,468	Examiner: Nguyen, Nga B.
Filed: February 12, 2001	
For: SYSTEM AND METHOD FOR PROVIDING EXTRA LINES OF CREDIT	Confirmation No.: 6389
	Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the Final Office Action mailed May 18, 2006. This Request is being filed concurrently with a Notice of Appeal.

I. Requirements For Submitting a Pre-Appeal Brief Request for Review

Applicants may request a pre-appeal brief review of rejections set forth in an Office Action if (1) the application has been at least twice rejected; (2) Applicants concurrently file the Request with a Notice of Appeal prior to filing an Appeal Brief; and (3) Applicants submit a Pre-Appeal Brief Request for Review that is five (5) or less pages in length and sets forth legal or factual deficiencies in the rejections. *See* Official Gazette Notice, July 12, 2005.

Applicants have met each of these requirements and therefore request review of the Examiner's rejections in the Final Office Action for the following reasons.

II. The Rejection Under 35 U.S.C. § 103(a) is Legally Deficient Because the Examiner Mischaracterizes Applicants' Response to the Examiner's Official Notice

In the Final Office Action, the Examiner mischaracterizes Applicants' response to the Examiner's Official Notice that certain claimed features missing from *Marshall* were well known. Indeed, the Examiner improperly asserts that Applicants have "not challenged the correctness of the assertions, only the [use] of Official notice." (Final OA at 3.) Applicants respectfully disagree with the Examiner's assertion, and direct the Examiner to the Request for Reconsideration filed on January 13, 2006 ("the Request"), which specifically addresses the deficiencies in the Examiner's position regarding Official Notice. Specifically, Applicants presented arguments showing that the Examiner's position "does not even address all of the recitations of claim 1." *See* the Request at 4-6. Contrary to the Examiner's position, Applicants have not merely requested evidence from the Examiner to support the alleged Official Notice, but have also presented arguments that challenge "the correctness of the [Examiner's] assertions" and have shifted the "burden to the examiner to provide [evidence] in support of the official notice." *See* OA at 3. Accordingly, the Examiner's response to Applicants' arguments regarding Official Notice is improper and cannot continue to support the rejection of claims 1-10, 26-43, 60-66, and 72-78 under 35 U.S.C. § 103(a). Therefore, for at least this reason, the rejection is legally deficient and should be withdrawn.

III. The Rejection Under 35 U.S.C. § 103(a) is Legally Deficient Because the Examiner has not Provided Evidence to Support the Alleged Official Notice

In the Request, not only did Applicants point out the deficiencies of the Examiner's position regarding Official Notice, Applicants also requested the Examiner to provide a reference to support the position pursuant to M.P.E.P. § 2144.3(A). *See* the Request at 4-5. As noted in the Request, the Board must have some "concrete evidence in the record" to support the Examiner's findings. Nonetheless, even after Applicants' request, the Examiner has still yet to produce a reference to support the alleged Official Notice that the claimed features missing from *Marshall* would have been well known in the art. As a result, the rejection under 35 U.S.C. § 103(a) remains unsupported by evidence to support the examiner's assertions and thus is legally deficient and should be withdrawn.

IV. The Rejection Under 35 U.S.C. § 103(a) is Legally Deficient Because the Examiner's Official Notice Does not Address the Recitations Missing from *Marshal*, as Admitted by the Examiner.

Moreover, in rejecting claims 1-10, 26-43, 60-66, and 72-78, the Examiner acknowledges that *Marshall* does not teach the claimed "processing" and "notifying" steps. (Final OA at 5.) Yet, the Examiner alleges that these limitations are well known in the art and provides hypothetical examples of existing credit systems where, "customers usually receive the letter included credit cards by mail instructs the customers to activate credit cards by calling the toll free numbers of the credit card company" and "customers usually receive the credit card statements included credit limits, outstanding balances, interest applied, purchase histories, special offers, etc." (Final OA at 5.)

As explained in the Request, such allegations are conjecture and do not address the above noted claim recitations. *See* the Request at 4-7. For example, letters sent to customers to activate credit cards, as alleged by the Examiner, do not constitute the claimed "processing responses to the offers...and activating at least one extra line of credit to the existing credit card account" (emphasis added), as recited in independent claim 1. The Request at 5-6. As such, the Examiner's assertion that the claimed features are well known is legally deficient because it does not address the recitations the Examiner admits are missing from the cited art. As a result, the Examiner has failed to establish a *prima facie* case of obviousness in rejecting claims 1-10, 26-43, 60-66, and 72-78 under 35 U.S.C. § 103(a).

V. The Examiner's Interpretation of Claim Terms are Unreasonable and Improper Under M.P.E.P. § 2111

In rejecting claim 1 under 35 U.S.C. § 103(a), the Examiner asserts that "credit limit[]," as disclosed in *Marshall*, is the same as the claimed "credit line." (Final Office Action at 2.) As explained in the Request, the Examiner continues to improperly and unreasonably interpret claim terms to apply the cited art against the pending claims because a credit limit is not the same as a credit line. *See* the Request at 3-4. Although the Examiner is entitled to interpret claim terms broadly, such interpretation cannot be unreasonable. Indeed, M.P.E.P. § 2111 indicates "pending claims must be given their broadest reasonable interpretation consistent with the specification." While the Examiner may not be required "to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit," the Examiner is required to apply "to

verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification." *Id.* Accordingly, the broadest reasonable interpretation of "credit line" must be consistent with the interpretation of the term that those skilled in the art would reach. *See Id.* Clearly, a credit limit, which as explained in the Request, may, for example, be an attribute of a credit line, but cannot represent the same thing as a credit line. *See* the Request at 4.

Accordingly, the Examiner's interpretation of a credit line is unreasonable in view of that known in the art and in the context of Applicants' specification, which is inconsistent with M.P.E.P. § 2111. Therefore, the Examiner's rejection under 35 U.S.C. § 103(a) is legally deficient and should be withdrawn.

VI. The rejection under 35 U.S.C. § 103(a) is Legally Deficient Because The Examiner Did Not Establish that *Marshall* Teaches or Suggests Presenting an Offer for an Extra Credit Line to Each Customer in the Target Customer Group

Even assuming that a "credit limit" is the same as the claimed "credit line" (a position Applicants adamantly oppose), independent claim 1 recites "presenting an offer for an extra credit line" (emphasis added). In contrast, *Marshall* discloses a system where banks raise credit limits automatically for "good customers." *Marshall*, para. 14. Thus, these customers are not presented with an offer for their increase of a credit limit, much less an offer for an extra credit line (which is different from a credit limit of an existing credit line). *Marshall*, therefore, fails to support the rejection of claim 1 under 35 U.S.C. § 103(a). Further, independent claims 26, 34, 60, and 72, while of different scope than independent claim 1, recite subject matter similar to that of independent claim 1. Thus, independent claims 26, 34, 60, and 72, and dependent claims 2-10, 27-33, 35-43, 61-66, and 73-78 are allowable at least for the same reasons presented above and in the Request in connection with claim 1.

VII. The Rejection of Claims 26-33 and 60-66 is Legally Deficient Because the Examiner Failed to Address the Recitations of These Claims

The Examiner rejects claims 26-33 and 60-66, and 72-77 for the same reasons as claims 1-10. *See* Final OA at 8. However, independent claims 26 and 60 recite, for example,

that "the customer may use the extra credit line to purchase goods and services after being notified." The Examiner does not address this recitation in the Office Action. 37 C.F.R. § 1.104(c) requires the Examiner to provide more than merely stating a reference meets the limitations of a rejected claim. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." 37 C.F.R. § 1.104(c)(2). In this case, the Examiner improperly ignores recitations of independent claim 26 and 60 and their dependent claims. As such, the Examiner's rejection of each of these claims under 35 U.S.C. § 103(a) does not meet the requirements of 37 C.F.R. § 1.104, and thus is improper. By ignoring the recitations of claims 26-33, and 60-66, the Examiner has failed to show how the cited art teaches or suggests the recitations of these claims. As a result, the rejection of each of these claims do not meet the requirements of at least M.P.E.P. § 2143 and 35 U.S.C. § 103(a), and thus is improper.

VIII. Conclusion

In light of the above arguments and those presented in the Request, Applicants submit that the rejections under 35 U.S.C. § 103(a) are legally deficient and improper. Therefore, the rejection of claims 1-10, 26-43, 60-66, and 72-78 should be withdrawn and the claims allowed.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 18, 2006

By: Patrick Miller
Patrick L. Miller
Reg. No. 57,502